

REMARKS

Claims 130-137 were pending in the present application. In Office Action mailed September 21, 2005, the Examiner rejected Claims 130-137 as allegedly being anticipated by Kim et al., 1998 J. Braz. Chem. Soc. 4:375-379 (hereinafter, "the Kim reference"). The Applicants filed a Response on January 23, 2006, wherein Claims 134-137 were canceled, Claims 130-132 were amended, and new Claims 138-140 were added.

In the Office Action mailed April 11, 2006, the Examiner objected to the amendments of Claims 130-132 and new Claims 138-140. In particular, the Examiner stated, "The original claims are drawn to a pharmaceutical product not a compound which patentably independent invention from the composition." The Applicants now amend Claims 130-132 and Claims 138-140 such that "composition" is replaced with "compound."

For the convenience of the Examiner the January 23, 2006 Response to the September 21, 2005 Office Action is re-presented below in its entirety.

I. Claims 130-137 are Rejected Under 102(a)

Claims 130-137 are rejected under 35 U.S.C. §102(a) as being anticipated by the Kim reference. In particular, the Examiner alleges, "The claims are drawn to a compound having the structure as claimed in claim 130. Claim 135 is specifically drawn to a compound having a structure as shown in claim 135 (=Bz-423). Claim 137 is drawn to a pharmaceutical composition using said compound. Kim et al teach a 3-substituted 1,4-Benzodiazepin-2-ones such as compound 1 at page 375. The compound 1 of Kim et al is same compound required in claim 135. Since the said compound 1 of Kim et al is a specie that is encompassed by the generic formula required claim 130-134. Thus, all the limitations required by the claims 130-134 are well anticipated by the cited reference. As to claim 137, at abstract, Kim et al teach that the preparation has been formulated for animal study. Thus, one would have been envisioned the pharmaceutical composition using the said compound 1 suitable for carrying out the administration to animal. Thus, all the critical elements required by claim 130 and its dependent claims are well taught and the claim is anticipated." Office Action, page 3.

The Applicants respectfully disagree. However, in order to expedite prosecution, the R1 group within Claim 130 is now amended such that the phrase “aliphatic and aryl” is replaced with the phrase “an aliphatic group having at least 2 carbons, a substituted aliphatic group having at least 2 carbons, an aryl group, and a substituted aryl group.” In addition, Claims 134-137 are now canceled. The Applicants reserve the right to prosecute the original Claims 130 and 134-137 or similar claims in the future. The Kim reference does not teach or suggest the compounds described by amended Claim 130.

The Applicants now further amend Claim 130 such that the naphthalene subgroup located at position 3 of the benzodiazepine ring is replaced with an R4 subgroup wherein R4 is aliphatic, substituted aliphatic, aryl, substituted aryl, NH₂, or a group that participates in hydrogen bond formation. This amendment to Claim 130 does not constitute new matter. Support for amended Claim 130 is located, for example, at paragraphs 0018 and 0151 of the Specification.

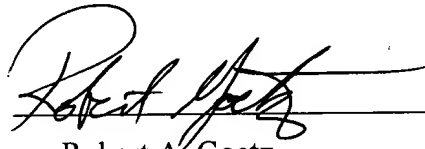
The Applicants also now provide new Claims 138-140. New Claims 138-140 do not constitute new matter. Support for Claim 138 is located, for example, at paragraph 0163 of the specification. Support for Claims 139 and 140 are located, for example, at paragraphs 0064, 0110, 0124, 0129 and 0134. The Kim reference does not describe the compounds described by new Claim 138. The Kim reference does not describe pharmaceutical compositions described by new Claims 139 and 140. As such, new Claims 138-140 are not anticipated by the Kim reference.

CONCLUSION

All grounds of rejection of the Office Action of September 21, 2005 and April 11, 2006 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that Applicant's new claims should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

Dated: _____

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